

REMARKS

Receipt of the Office Action mailed June 11, 2002 is acknowledged. This paper is intended to be a full and complete response to that communication. Claims 1-22 are currently pending in the application. All of which, stand rejected under various sections of 35 U.S.C.

I. Rejections Under 35 U.S.C. § 103

Claims 1-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kasahima et al. (USPN 6,241,627) in view of Kennedy, III et al. (USPN 6,325,731). Applicants respectfully traverse the rejection of claims 1-22 of the instant application. The cited combination fails to teach either singly or in combination the instant claimed invention.

Kasashima et al teaches a golf ball having 20 triangles having the smallest dimples placed at the vertex of the triangles. (Abstract) Figure 2 **DISPLAYS** dimples that appear to be intersecting the great circle line and the specification is silent regarding dimples on the great circle line. The Examiner's statement "*It is also noted that the dimple arrangement as set forth in Figure 1 may be adjusted without departing for the ranges set forth.* Therefore, to have any number of rows within the triangle

would constitute as a design choice." This statement is immaterial since it reflects a lack of teaching of the Kasashima disclosure regarding dimple placement.

The prima facia case of obviousness has not been met because without using the applicants own specification for guidance the Kasashima disclosure fails to provide teaching or motivation to place the dimples within the triangle as claimed, fails to provide motivation to have a great circle free of dimples, fails to provide motivation for placement of the types of dimples as claimed. Furthermore the applicants agree that there is no teachings present regarding core compression and cover hardness. Therefore Kasashima either singly or in combination fails to teach the claimed features and thus claims containing those limitations are allowable.

Kennedy III teaches a multi-layer golf ball having a core with a PGA compression of 100 or less and more preferably a PGA compression of 90 or less. The outer cover has a hardness of 55 or less and more preferably 50 or less. The outer cover comprises a blend of 3 to 25% hard ionomer and 75 to 95% soft ionomer. The Examiner suggests that "One of ordinary skill in the art knows that combining a terpolymer with the above softens the composition". Kennedy III fails to teach or suggest the

instant invention which is a two-piece ball. The Examiner is correct that Kennedy teaches specific components for a multi-layer ball but fails to teach or suggest that the features are applicable to a two piece ball.

Kennedy states or teaches the following: "Disclosed herein is a multi-layer ball having a soft outer cover."(Abstract); "The **combination** of a hard inner cover layer with a soft, relatively low modulus ionomer, ionomer blend or other non-ionomeric thermoplastic elastomer outer cover layer provides for excellent overall coefficient of restitution (i.e., excellent resilience) **because of the improved resiliency provided by the inner cover layer.**" While some improvement in resiliency is also produced by the outer cover layer, the outer cover layer generally provides for a more desirable feel and high spin, particularly at lower swing speeds with highly lofted clubs such as half wedge shots."(Col. 6, line 61 to Col. 7 line 3); "This golf ball is **superior to conventional soft covered two-piece or wound balls** in that it has lower spin off a driver and higher spin on short shots." (Col. 27 line 9-11)

The teachings of Kennedy III should not be combined with that of Kasashima to produce the instant inventions two piece golf ball. Kennedy clearly teaches away from the

use of its cover blend if not used in combination with the core and mantle layer. Specifically as discussed above the soft cover disclosed on a two piece ball gives deficient properties. Additionally while the specification teaches a broad PGA range it then selects only examples outside of the instant invention's range as preferable in their combination.

While the cited references have certain features of the instant claimed invention they fail to motivate one to produce the claimed golf ball. The instant claimed golf ball is desirable because of its specific combination and not because of any properties of the individual components. The Federal Circuit held that:

"[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference. . . . Rather, we look to see whether combined teachings render the claimed subject matter obvious." See In re Wood, 599 F.2d 1032, 202 USPQ 171, 174 (C.C.P.A. 1979) (emphasis added) (citing In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549-50 (C.C.P.A. 1969))

Claims 1-22 are allowable because the cited references of Kasashima and Kennedy III fail to teach each and every limitation of all claims. If the teachings of the references were followed then a multi-layer ball having a

soft outer cover and a hard inner cover having twenty triangles with dimples having completely different placement would result, but not the instant invention. The failure to form a prima facie case of obviousness should result in a removal of the obviousness rejection and allowance of all claims is respectfully requested.

II. DOUBLE PATENTING REJECTION

The Office rejects claims 1-23 under the judicially created doctrine of obviousness-type double patenting over claims 1-22 of U.S. Patent No. 6,383,093 in view of Kennedy III et. The applicants respectfully request removal of the double patenting rejection and allowance of the application for the following reasons. It is improper to reject an application for double patenting if it must be combined with a separate reference (especially one not owned by the assignee-Kennedy III). Additionally the KUTTAPPA '093 patent has a completely different dimple pattern than the instant invention and thus is substantially different and thus fails under the double patenting rejection test. Applicant respectfully requests withdrawal of the rejection in light of the aforementioned reasons.

III Conclusion

Based on the foregoing discussion, it is respectfully requested that all rejections be withdrawn and the application passed to issue.

Respectfully submitted,


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